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REED SMITH LLP
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103

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| EXAMINER |
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GRAY, LINDA LAMEY

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| ART UNIT | PAPER NUMBER |
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1734

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,025

Applicant(s)

PAWLIK ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Claim Rejections - 35 USC 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartner et al. (US 5,284,363).

Claim 1, Gartner et al. teach apparatus 8, for example, the apparatus shown in Figures 5A and 5B. The apparatus includes first and second substantially planar members 20 and 10/40, respectively, which are releasably adhered to each other in a peelable and resealable fashion (c 5, L 48, to c 6, L 16; c 3, L 51, to c 4, L 31). Gartner et al. teach that the apparatuses in the patent may include one predefined tearing region 39 within the edges of both members 20 and 10/40 (Fig 1) where region 39 includes perforations and is suitable for being partially and/or torn fully (c 4, L 31-37). With respect to the intended use limitations of "for labeling a roll of product" and "to access a corresponding portion of the product when the apparatus is secured about the roll", apparatus 8 is considered capable of performing this intended use in that apparatus 8 could be placed as a label on a roll product such as a cylindrical container. Also, if region 39 were torn the a portion of the product (i.e., cylindrical container) could be accessed at the same portion through member 20 since such is made of plastic and therefore the product could be visible therethrough when member 20 is transparent.

Claims 2-3, apparatus 8 of Gartner et al. is capable of performing these further limited intended use limitations in that cylindrical containers such as pharmaceutical bottles houses substrates (i.e., pills for example) (**claim 2**) which are sometimes individually wrapped in foil (**claim 3**) where apparatus 8 is capable of being applied to such products. **Claim 4**, apparatus 8 of Gartner et al. is capable of performing this further limited intended use limitation in that such products have initial vertical lengths from the bottom of the neck to the bottom of product where members 20 and 101/40 have a vertical width which could approximate to this length. **Claim 5**, apparatus 8 of Gartner et al. is capable of performing this further limited intended use limitation in that such products have an given perimetrical circumference where members 20 and 10/40 have a height (length around the product) which could approximate this circumference. **Claim 6**, members 20 and 10/40 each include first and second: first surfaces 22 and 28 with second surfaces 33 and 45. Surfaces 22, 33, 28, and 45 include visible indicia 18. **Claim 7**, a portion of surface 22 includes adhesive 25 thereon. **Claim 8**, the adhesive on surface 22 is capable of performing this further limited intended use limitation in that adhesive 22 adheres would be used to adhered apparatus 8 to the product.

3. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Bernier et al. (US 6,637,775 B1).

Claim 1, Bernier et al. teach apparatus 10 including first and second substantially planar members 14 and 12, respectively, releasably adhered to each other in a peelable and resealable fashion (c 2, L 53, c 3, L 49). Bernier et al. teach one predefined tearing region 42 within the edges of both members 14 and 12 (Fig 3) where region 42 includes perforations and is suitable for being partially and/or torn fully (c 3, L 40-49). With respect to the intended use limitations of "for labeling a roll of product" and "to access a corresponding portion of the product when the apparatus is secured about the roll", it is noted Bernier et al. teach that apparatus 10 is for labeling a roll product 11 (i.e., roll shaped bottles 11; c 2, L 52-55) with member 14 closest to product 11. Also, when region 42 is torn, one can access a corresponding portion of

product 11 when apparatus 10 is secured about product 11 in that member 14 is opaque and thus product 11 is visible (accessible) to a degree thereunder (c 3, L 50-56).

Claims 2-3, apparatus 10 of Bernier et al. is capable of performing these further limited intended use limitations in that product 11 houses substrates (i.e., pills for example) (**claim 2**) which are sometimes individually wrapped in foil (**claim 3**). **Claim 4**, apparatus 10 of Bernier et al. is capable of performing this further limited intended use limitation in that Figure 1 of Bernier et al. demonstrates product 11 to have an initial vertical length from the bottom of the neck to the bottom of product 11 where members 14 and 12 have a vertical width approximately equal to this length. **Claim 5**, apparatus 10 of Bernier et al. is capable of performing this further limited intended use limitation in that Figure 1 of Bernier et al. demonstrates product 11 to have an given perimetrical circumference where members 12 and 14 have a height (length around product 11) approximately equal to this circumference. **Claim 6**, members 14 and 12 each include first and second surfaces: first top surface 20 and second bottom surface 22 of member 14; first top surface 16 and second bottom surface 18 of member 12. Surfaces 16, 18, and 20 have visible indicia 24, 26, and 30 thereon. **Claim 7**, surface 22 includes an adhesive. **Claim 8**, the adhesive on surface 22 is capable of performing this further limited intended use limitation in that adhesive 22 adheres apparatus 10 to product 11.

Claim Rejections - 35 USC 103

4. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner et al.

Claim 9, Bernier et al. do not teach member 10/40 to be smaller than member 20.

The relative sizes members 10/40 and 20 is a result-effective variable in that changes in size effect the appearance of apparatus 8, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Gartner et al. an optimization of the relative size of member 10/40 compared to the that of member 20 for optimal appearance of apparatus 8.

Claim 10, surface 45 includes an adhesive thereon which is deadened in inner portions 38a (**claim 11**). **Claim 13**, member 10/40 includes an outer edge where the deadening is adjacent the edge (**claim 14**).

Claims 12 and 15, Bernier et al. do not teach deadening 30%-50% and 5% of the edge.

MPEP 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955). In this case, the range is the range percent of deadening. Also, the degree of deadening is a result-effective variable which effects the degree of releasability between members 10/40 and 20. Based upon this line of reasoning, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Gartner et al. an optimization of the percent of deadening for optimal release and reseal.

5. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernier et al.

Claim 9, Bernier et al. do not teach member 12 to be smaller than member 14.

The relative sizes members 12 and 14 is a result-effective variable in that changes in size effect the appearance of apparatus 10, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Bernier et al. an optimization of the relative size of member 12 compared to the that of member 14 for optimal appearance of apparatus 8.

Claim 10, surface 18 includes an adhesive thereon which is deadened in inner portions (**claim 11**). **Claim 13**, member 12 includes an outer edge where the deadening is adjacent the edge next to adhesive areas 50 (**claim 14**).

Claims 12 and 15, Bernier et al. do not teach deadening 30%-50% and 5% of the edge.

MPEP 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955). In this case, the range is the range percent of deadening. Also, the degree of deadening is a result-effective variable which effects the degree of releasability between members 12 and 14. Based upon this line of reasoning, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Bernier et al. an optimization of the percent of deadening for optimal release and reseal.

Response to Applicant's Amendment and Comment

6. Applicant's comments filed 9-14-05 have been fully considered.

With respect to Applicant's comments concerning the election, election was made with traverse as applicant stated.

Applicant indicates that neither Gartner nor Bernier teach a labeling apparatus having at least one predefined tearing region within the first and second substantially planar members.

In response, Gartner et al. teach that the apparatuses in the patent may include one predefined tearing region 39 within the edges of both members 20 and 10/40 (Fig 1). Bernier et al. teach one predefined tearing region 42 within the edges of both members 14 and 12 (Fig 3). The rejection over Sellars is removed in that Sellars is not capable of performing the intended use of "for labeling a roll of product" in that Sellars teaches making a pouch for holding product and is not for labeling.

Applicant indicates that the label of Gartner nor Bernier contains predefined tearing regions for accession to a product.

In response, apparatus 8 of Gartner et al. is considered capable of performing this intended use in that apparatus 8 could be placed as a label on a roll product such as a cylindrical container. Also, if region 39 were torn the a portion of the product (i.e., cylindrical container) could be accessed at the same portion through member 20 since such is made of plastic and therefore the product could be visible therethrough when member 20 is transparent. Also, apparatus 10 is for labeling a roll product 11 (i.e., roll shaped bottles 11; c 2, L 52-55) with member 14 closest to product 11. Also, when region 42 is torn, one can access a corresponding portion of product 11 when apparatus 10 is secured about product 11 in that member 14 is opaque and thus product 11 is visible (accessible) to a degree thereunder (c 3, L 50-56).

This Office action is non-final to the changes in the prior art rejections to Gartner et al. and Bernier et al. with respect to claims 2-5, 8-9, 12, and 15.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public Pair. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-1997 (toll-free).

llg 
March 20, 2006


LINDA GRAY
PRIMARY EXAMINER